

### Remarks

A Request for Continued Examination (RCE) is filed herewith, and because the RCE and the present Amendment are submitted within the three-month time period for response to the Final Office Action dated August 13, 2007, the present Amendment is timely filed.

The Final Office Action mailed August 13, 2007 and the Advisory Action dated October 1, 2007 have been carefully reviewed and the foregoing amendment has been made in consequence thereof. Claims 1-39 are now pending in this application. Claims 21-39 are newly added. It is respectfully submitted that the present claims define allowable subject matter.

#### A. The 102 Rejection over Bradshaw et al.

The rejection of Claims 1, 2, 3, and 5 under 35 U.S.C. § 102(b) as being anticipated by Bradshaw et al. (U.S. Patent No. 6,161,698) is respectfully traversed.

Bradshaw et al. describe a carrying case 10 that includes an elongated outer cover 12 having a top end 14 and a bottom end 16. The outer cover 12 forms a cavity 36 therein for storing a golf bag and other golf accessories. The golf bag carrying case 10 also includes a clubhead protection system. A first protective member 48 is disposed within the cavity 36 near the top end 14 of the outer cover adjacent the clubheads 50 of the golf clubs 52. A second protective member 58 is provided opposite the first protective member 48. The protective members 48 and 58 are rectangular in shape and have respective first ends 49 and 57 attached to the interior of the outer cover 12 and respective second ends 51 and 59 that are free. In use, the second end 51 of the first protective member 48 is wrapped around the irons 53 in the golf bag 56, and the second end 59 of the second protective member 58 is then wrapped around the woods 55 and removably secured to the first protective member 48. The first and second protective members 48 and 58 take up the space between the golf clubs 52 to prevent them from sliding around in the golf bag 56 during transport. The protective members 48 and 58 also provide padding between the golf clubs 52 to prevent marring and scratching of the clubheads 50. However, nothing in Bradshaw et al. describes anything that extends over and engages the tops of the golf club heads.

In the final Office Action at page 4, the Examiner references Figures 6 and 12 of Bradshaw, and makes a special mention of Figure 12 indicating “Fig. 12 clearly shows the cover engage a plurality of clubs”. Presumably, the examiner is referring to the first and second protective members 48 and 58 disclosed by Bradshaw. Applicant agrees. However, the language of Claim 1 does not merely state that the cover engages the clubs. Rather, Claim 1, in part, recites that the helmet is configured to extend over and engage the top of the heads of said golf clubs. It should be apparent from the disclosure, and for that matter from the prior art, what is considered the top of a golf club head. The top of the golf club is the uppermost portion of the golf club when referenced to an upright golf bag that contains the club. Again, this perspective is apparent from the disclosure. At best, Bradshaw can be construed as the first and second protective members 48 and 58 wrapping around the golf club heads as is best illustrated by Figure 12 of Bradshaw. There can be no reasonable interpretation of Bradshaw that can be used to anticipate the recitations of Claim 1, specifically the recitation that includes, “extend over and engage the top of the heads of said golf clubs”.

Further, and also at page 4 of the final Office Action, the Examiner asserts that the term “extend” as used in the claim recitation “extend over” denotes any coverage of the cover (e.g., helmet) beyond the clubs. Applicant disagrees, and respectfully submits that the term “extend over” is simply indicating that the part of the helmet that engages the golf club heads is above those heads. Since the final Office Action uses the term “beyond the clubs”, it is believed that the Examiner is misinterpreting the term “extend over” to mean “extend past”.

With respect to the phrase “adapted to constrain said golf clubs from moving in a direction along said longitudinal axis”, the Examiner asserts that the phrase does not impart any structure over the disclosure of Bradshaw. Applicant disagrees. It is conceded that the configuration of Bradshaw illustrated in Figure 12, namely the first and second protective members 48 and 58, might be utilized in such a way so that movement of the clubs in a direction into and out of the page (along the longitudinal axis) might be impeded, but such movement is definitely not constrained. To finish the references to the final Office Action, at least with respect to Bradshaw, the Examiner states that the attachment means of 62/60 would enable one to tightly engage the clubs and therefore constrain the clubs from moving in a direction along the longitudinal axis of the clubs. This statement of function completely ignores the structural

recitations in Claim 1 in regard to the claimed helmet and top of the golf club heads. Referring to MPEP 2114, even if the prior art device performs all the functions recited in the claim, the prior art cannot anticipate the claim if there is any structural difference. *In re Ruskin*, 347 F.2d 843, 146 USPQ 211 (CCPA 1965) as implicitly modified by *In re Donaldson*, 16 F.3d 1189, 29 USPQ2d 1845 (Fed. Cir. 1994). In the instant case, the device of Bradshaw does not even perform all the functions recited in the claim, and the structural differences are extensively discussed herein.

It is well settled that there is no prohibition on the use of functional language to impart a structure. Additionally, any functional limitations must be evaluated and considered, just like any other limitation of the claim. See MPEP § 2173.05(g) However, the recitations of Claim 1 include both distinguishing structural in addition to the functional language. The phrase “adapted to constrain said golf clubs from moving in a direction along said longitudinal axis” imparts a structure as well as a function. The phrase is included in Claim 1 to provide clarification to the recitation “configured to extend over and engage the top of the heads of said golf clubs” which also imparts a structure. When the two phrases are considered together, as they are recited in Claim 1, the recitations do indeed impart a structure that is distinct from the cover disclosed in Bradshaw.

However, to expedite prosecution and allowance of the pending Claims, Claim 1 has been amended to recite a golf bag carrier that comprises “a body comprising a longitudinal axis and defining a cavity adapted to contain a golf bag with a set of golf clubs therein” and “an adjustable and flexible helmet attached to said body within said cavity, said helmet configured to extend over and engage the top of the heads of said golf clubs, in an orientation substantially perpendicular to shafts of said golf clubs, and adapted to constrain said golf clubs from moving in a direction along said longitudinal axis.”

As explained extensively above, Bradshaw et al. do not describe nor suggest an adjustable and flexible helmet configured to extend over and engage the top of the heads of said golf clubs in an orientation substantially perpendicular to shafts of said golf clubs. Rather, Bradshaw et al. describe rectangular shaped pads that wrap around a perimeter defined by the golf clubs and the golf club heads, but not a structure that extends over the tops of the golf club

heads. Further, Bradshaw et al. do not describe or suggest a separate helmet as recited in presently pending Claim 1. Rather Bradshaw et al. describe a golf club bag carrying case that includes rectangular shaped pads attached therein. Additionally, the top end 14 of the carrying case 10 does not appear to engage the golf club heads.

For the reasons set forth above, Claim 1 is submitted to be patentable over Bradshaw et al.

With respect to claim 2, the protective members 48 and 50, for the reasons set forth above, cannot be considered the helmet recited in claim 1. Claim 2 similarly recites that the helmet includes a head portion and a shaft portion, the head portion extending substantially perpendicular to the longitudinal axis of the clubs and the shaft portion extending generally parallel to the longitudinal axis. Because neither of the protective members 48 and 50 of Bradshaw et al. extend substantially perpendicular to the longitudinal axis of the clubs, Bradshaw does not anticipate claim 2.

Claim 3, when considered in combination with the recitations of claim 1, is not anticipated by Bradshaw et al. for the reasons explained above.

Also, specifically with respect to claim 5, the protective members 48 and 50 of Bradshaw et al. are each disclosed as having a first end attached to the outer cover and the second end being free. See col. 4, lines 16-29. That is, Bradshaw et al. clearly discloses more than one protective member, and each of the protective members have only one free end. Claim 5, however, recites a protective member having a first free end and a second free end. This is clearly distinguishable, and claim 5 is not anticipated by Bradshaw et al.

For the reasons set forth above, Applicants respectfully request that the Section 102 rejection of Claims 1, 2, 3, and 5 be withdrawn.

#### B. The 102 Rejection over Rea

The rejection of Claims 1, 4-6, 7-13, and 16-19 under 35 U.S.C. § 102(b) as being anticipated by Rea (U.S. Patent No. 3,245,448) is respectfully traversed.

Rea describes a bag for carrying and storing skis. The bag includes a body 10 having a lining 12. Inside the lining 12 are partition forming means 26. As shown in Figure 2, means 26 divides the bags into three portions. A lining 18 is attached to the end of the body 10. Stitching 22 secures the end 20 and lining 18 to the end of the body 10. Rea focuses on the partitions that can be made within the body 10 of the bag. However, nothing in Rea describes or suggests anything with respect to the lining 18 other than it's use as a lining for the plastic coated flexible fabric 20.

Again at page 4 of the final Office Action, and with respect to the Rea reference, the Examiner states that "the bag in Rea can be adapted to carry a golf bag as claimed". Applicants do not dispute that a golf bag (including clubs) might be capable of being placed within the bag of Rea. However, and more importantly, this statement has no bearing whatsoever on whether the disclosure of Rea anticipates the claimed invention. To anticipate a claimed invention, it is well known that the reference must disclose each and every feature of the claimed invention. It cannot be reasonably argued that Rea meets this standard, as further explained below.

There is no structure described by Rea that anticipate the claim recitation "an adjustable and flexible helmet attached to said body within said cavity, said helmet configured to extend over and engage the top of the heads of said golf clubs, in an orientation substantially perpendicular to shafts of said golf clubs, and adapted to constrain said golf clubs from moving in a direction along said longitudinal axis".

The examiner equates the lining 18 disclosed by Rea to the claimed helmet. However, Rea describes this lining 18 as being attached to fabric 20 to form body 10. Simply put, the lining 18 goes where the fabric 20 goes. It is not separately operable. None of the body 10, the fabric 20, or the lining 18, described by Rea are separately operable to engage golf club heads to restrain movement in the longitudinal direction. The only resistance to longitudinal movement provided by the bag of Rea are the dimensions of the bag itself. Therefore, Rea does not describe both a distinct body and helmet as is recited in Claim 1.

Further, the Examiner indicates that the partition forming means 26 and their ends 34 may be overlapped. However, these devices extend along the longitudinal axis of the body. Similar to the explanation above with respect to Bradshaw, the partition forming means 26 might

be utilized in such a way so that movement of the clubs in a direction along the longitudinal axis might be impeded somewhat, but such movement is not constrained. Finally, the partition forming means 26 is not configured to extend over and engage the top of the heads of said golf clubs, in an orientation substantially perpendicular to shafts of said golf clubs, as is recited in the claim.

As also explained above, to expedite prosecution and allowance of the pending Claims, Claim 1 has been amended to recite a golf bag carrier that comprises a body comprising a longitudinal axis and defining a cavity adapted to contain a golf bag with a set of golf clubs therein" and "an adjustable and flexible helmet attached to said body within said cavity, said helmet configured to extend over and engage the top of the heads of said golf clubs, in an orientation substantially perpendicular to shafts of said golf clubs, and adapted to constrain said golf clubs from moving in a direction along said longitudinal axis."

Rea does not describe nor suggest a golf bag carrier that includes an adjustable and flexible helmet configured to extend over and engage the top of the heads of said golf clubs. Additionally, Rea does not describe or suggest that this helmet is adapted to constrain golf clubs from moving in a direction along said longitudinal axis or that the helmet orientation is substantially perpendicular to the golf club shafts. Nothing in the disclosure of Rea suggests that it would constrain skis and poles from moving in the longitudinal axis, that is, an axis that extends through the bag and parallel to the fastener 24 and perpendicular to 27 and 29, as best shown in Figure 1 of Rea. While it may be conceivable that a user would utilize the bag of Rea to hold their golf bag and golf clubs, nothing in Rea is descriptive of a device that would engage the ends of the skis and poles, which would be analogous to "extend over the top of the heads of" the golf clubs. Rather, Rea describes linings and partitions that extend along the length of the bag (ending at 27 and 29 (see Figure 1)), separating skis and poles along the longitudinal axis. As such, Rea does not describe anything that would prevent movement of items therein along its longitudinal axis.

For the reasons set forth above, Claim 1 is submitted to be patentable over Rea.

Claims 4-8 depend, directly or indirectly, from independent Claim 1. When the recitations of Claims 4-8 are considered in combination with the recitations of Claim 1, Applicant submits that dependent Claims 4-8 likewise are patentable over Rea.

Again referring to the final Office Action, at both instances where the Rea reference is mentioned, the bottom of page 2 and the bottom of page 4 extending onto page 5, Applicant notes that the claimed sleeve is never mentioned. Again, as the Examiner should be well aware, for a proper 35 U.S.C. §102 rejection, each and every element of a claim must be found in the reference. The disclosure of Rea does not include a sleeve. Therefore Rea does not describe or suggest a protective member received in a sleeve.

Claim 9 recites a golf bag carrier comprising “a body comprising a longitudinal axis and defining a cavity adapted to contain a golf bag with a set of golf clubs therein, said body comprising at least one sleeve within said cavity” and “a protective member received in said sleeve, the protective member having a first free end and a second free end, said first free end configured to extend circumferentially around the golf bag and said second free end configured to extend circumferentially around the golf bag”.

Rea does not describe or suggest a sleeve within a cavity. The lining 12 in Rea is not operable as a sleeve even though most of its area is not attached to body 10. Therefore Rea also does not describe or suggest a protective member, as recited, that is received in the sleeve. Finally, while Rea describes various structures that might be considered “a protective member”, these structures do not meet the claim recitation of having a first end and a second end that extend circumferentially around the golf bag. For all of these reasons, Claim 9 is submitted to be patentable over Rea.

Claims 10-13 depend, directly or indirectly, from independent Claim 9. When the recitations of Claims 10-13 are considered in combination with the recitations of Claim 9, Applicants submit that dependent Claims 10-13 likewise are patentable over Rea.

Independent Claim 16 recites a golf bag carrier comprising “a body comprising a longitudinal axis and defining a cavity adapted to contain a golf bag with a set of golf clubs therein” and “a golf club protection assembly adapted to protect the golf club shafts and the golf

club heads, said protection assembly comprising an adjustable and flexible helmet configured to extend over the top of the golf club heads, in an orientation substantially perpendicular to shafts of said golf clubs, and adapted to constrain said golf clubs from moving in a direction along said longitudinal axis, and a protective member configured to extend circumferentially around the golf bag and the golf clubs".

As described above with respect to Claim 1, Rea does not describe nor suggest a golf club protection assembly that includes an adjustable and flexible helmet configured to extend over the top of the golf club heads. However to expedite prosecution and allowance of the claims, Claim 16 is amended herein as recited above. As described above, nothing in Rea is descriptive of a device that would engage the ends of the skis and poles, which would be analogous to "extend over the top of the heads of" the golf clubs. Additionally, nothing in the disclosure of Rea suggests that it would constrain skis and poles (or golf clubs) from moving in a direction along the longitudinal axis, that is, an axis that extends through the bag and parallel to the fastener 24 and perpendicular to 27 and 29. Additionally, Rea includes nothing adjustable and flexible that would extend over the top of the golf club heads, in an orientation substantially perpendicular to the shafts of the golf clubs. For all of these reasons, Claim 16 is submitted to be patentable over Rea.

Claims 17-19 depend, directly or indirectly, from independent Claim 16. When the recitations of Claims 17-19 are considered in combination with the recitations of Claim 16, Applicants submit that dependent Claims 17-19 likewise are patentable over Rea.

For the reasons set forth above, Applicants respectfully request that the Section 102 rejection of Claims 1, 4-6, 7-13, and 16-19 be withdrawn.

C. The 102 Rejection over Johnson

The rejection of Claims 1, 3-13, and 15-20 under 35 U.S.C. § 102(b) as being anticipated by Johnson (U.S. Patent No. 4,951,818) is respectfully traversed.

Johnson describes a carrier 10 having a hollow, elongated boxlike configuration including an openable top wall 12, a right side wall 9, a left side wall 14, a front end wall 16, a

rear end wall 8, and a bottom wall 13. As shown in Figure 3 of Johnson there is a space between the bottom of the golf bag and the front end wall 16 as well as a space between the golf club heads and the rear end wall 8.

Referring to the Johnson reference, page 3 of the final Office Action essentially ignores the claim recitations of independent Claims 1, 9, and 16, stating only that “Johnson teaches a body a helmet 8A and the zipper 56A is the locking assembly.” Seeking clarification, the undersigned then reviewed page 5 of the final Office Action. However, the only statement that is related to, for example, Claim 1 is a notation “that layer 8A, blocks the clubs moving longitudinally.” Therefore, “there is no structural difference between applicant’s device and portion 8A in Johnson.” Applicant disagrees. The Examiner’s position ignores the functional language within Claim 1 that further defines the structure of the claimed body, and of the claimed helmet.

Again referring to MPEP 2114, even if the prior art device performs all the functions recited in the claim, the prior art cannot anticipate the claim if there is any structural difference. *In re Ruskin*, 347 F.2d 843, 146 USPQ 211 (CCPA 1965) as implicitly modified by *In re Donaldson*, 16 F.3d 1189, 29 USPQ2d 1845 (Fed. Cir. 1994).

The Examiner’s interpretation seems to be that the walls of the Johnson device, except for panel 8A anticipate the body recited in Claim 1 and panel 8A is the helmet recited in the claim. However such an interpretation ignores the recitations of Claim 1 that the body defines a cavity adapted to contain a golf bag with a set of golf clubs therein. Presuming, for the moment, that panel 8A of Johnson meets the claim recitations to the helmet, then the Johnson device cannot possibly meet the recitations to the body, because without panel 8A the remaining “body” of Johnson cannot contain the golf bag and clubs therein.

As such, the device of Johnson does not meet the limitations of Claim 1 which is amended for the reasons provided above and recites a golf bag carrier that comprises “a body comprising a longitudinal axis and defining a cavity adapted to contain a golf bag with a set of golf clubs therein” and “an adjustable and flexible helmet attached to said body within said cavity, said helmet configured to extend over and engage the top of the heads of said golf clubs,

in an orientation substantially perpendicular to shafts of said golf clubs, and adapted to constrain said golf clubs from moving in a direction along said longitudinal axis.”

As described above, Johnson does not describe, nor suggest, both the claimed helmet and the claimed body, specifically, the adjustable and flexible helmet configured to extend over and engage the top of the heads of said golf clubs, in an orientation substantially perpendicular to shafts of said golf clubs, and adapted to constrain said golf clubs from moving in a direction along said longitudinal axis. While the rear end wall 8 of Johnson may eventually engage the tops of the golf club heads, it would only be due to a shifting of the bag or shifting of the clubs within the bag. The device of Johnson is configured to contain the movement of golf clubs while the device of the presently pending application is configured to constrain golf club movement. Therefore the carrier of Johnson does not describe or suggest anything that constrains golf clubs from moving in a direction along a longitudinal axis.

For the reasons set forth above, Claim 1 is submitted to be patentable over Johnson.

Claims 3-8 depend, directly or indirectly, from independent Claim 1. When the recitations of Claims 3-8 are considered in combination with the recitations of Claim 1, Applicant submits that dependent Claims 3-8 likewise are patentable over Johnson.

Claim 9 recites a golf bag carrier comprising “a body comprising a longitudinal axis and defining a cavity adapted to contain a golf bag with a set of golf clubs therein, said body comprising at least one sleeve within said cavity” and “a protective member received in said sleeve, the protective member having a first free end and a second free end, said first free end configured to extend circumferentially around the golf bag and said second free end configured to extend circumferentially around the golf bag”.

The device of Johnson does not meet these limitations. At page 5 of the final Office Action, the Examiner indicates that items 35 and 36 of the Johnson device are equivalent to the claimed protective member having a first free end and a second free end. First of all, there is nothing that suggests that items 35 and 36 are received in a sleeve. This observation in and of itself should be sufficient to disqualify Johnson as an anticipatory reference against Claim 9. However, Applicant submits that items 35 and 36 do not both extend circumferentially around

the golf bag as is required by Claim 9. As items 35 and 36 are meant to engage one another, as evidenced by the buckling mechanisms shown in Figure 4, they cannot therefore both extend around the circumference of a golf bag placed within the device of Johnson. For these reasons, Claim 9 is submitted to be patentable over Johnson.

Claims 10-13 and 15 depend, directly or indirectly, from independent Claim 9. When the recitations of Claims 10-13 and 15 are considered in combination with the recitations of Claim 9, Applicants submit that dependent Claims 10-13 and 15 likewise are patentable over Johnson.

Independent Claim 16 recites a golf bag carrier comprising “a body comprising a longitudinal axis and defining a cavity adapted to contain a golf bag with a set of golf clubs therein” and “a golf club protection assembly adapted to protect the golf club shafts and the golf club heads, said protection assembly comprising an adjustable and flexible helmet configured to extend over the top of the golf club heads, in an orientation substantially perpendicular to shafts of said golf clubs, and adapted to constrain said golf clubs from moving in a direction along said longitudinal axis, and a protective member configured to extend circumferentially around the golf bag and the golf clubs”.

As described with respect to Claim 16, Johnson does not describe nor suggest a golf club protection assembly that is adapted to constrain golf clubs from moving in a direction along said longitudinal axis. The Examiner’s position ignores the functional language within Claim 16 that further defines the structure of the claimed body, and of the claimed protection assembly which include the claimed adjustable and flexible helmet and claimed protective member.

The Examiner’s interpretation seems to be that the walls of the Johnson device, except for panel 8A anticipate the body recited in Claim 16 and panel 8A is the helmet recited in the claim. However such an interpretation ignores the recitations of Claim 16 that the body defines a cavity adapted to contain a golf bag with a set of golf clubs therein. Presuming, for the moment, that panel 8A of Johnson meets the claim recitations to the helmet, then the Johnson device cannot possibly meet the recitations to the body, because without panel 8A the remaining “body” of Johnson cannot contain the golf bag and clubs therein.

To expedite prosecution and allowance of the claims, the above recited and explained amendments have been made to Claim 16.

While the rear end wall 8 of Johnson may eventually engage the tops of the golf club heads, it would be due to a shifting of the bag or shifting of the clubs within the bag. Therefore the carrier of Johnson does not describe or suggest anything that constrains golf clubs from moving in a direction along a longitudinal axis. See Figure 3 of Johnson where it appears the golf clubs would be free to move in a longitudinal direction within the confines of the carrier 10. For all of these reasons, Claim 16 is submitted to be patentable over Johnson.

Claims 17-20 depend, directly or indirectly, from independent Claim 16. When the recitations of Claims 17-20 are considered in combination with the recitations of Claim 16, Applicants submit that dependent Claims 17-20 likewise are patentable over Johnson.

For the reasons set forth above, Applicants respectfully request that the Section 102 rejection of Claims 1, 3-13, and 15-20 be withdrawn.

D. The 102 Rejection over Salberg et al.

The rejection of Claims 1-3 under 35 U.S.C. § 102(b) as being anticipated by Salberg et al. (U.S. Patent No. 2,471,169) is respectfully traversed.

Applicant refers to page 5 of the final Office Action where the Examiner asserts that “the carrier device is portion 10, and the golf bag is portion 29 having a helmet portion 31 for constrain the golf clubs...”. The examiner has ignored the plain language of the reference. At Column 2, lines 17-18, Salzberg et al. explained that “10 denotes a golf bag”. At Column 2, lines 45-48, the device includes “a plurality of series of golf stick pockets 29 and 30...of narrow elongated form”. The golf stick pockets 29 and 30 are formed with upper sections 31 that extend above the mouth of the bag and are enlarged and shaped to fit the heads of golf clubs.

In the first instance, Salberg et al. do not describe a golf bag carrier. Salberg et al. describe a golf bag. The title of the Salberg et al patent is “Golf Bag”. More importantly, however, none of the features of the Salberg golf bag described in the final Office Action provide the structure and function that is incorporated into Claim 1. Specifically, items 29 and

31, which appear to be a single unit, do not constrain the golf clubs from moving in a direction along said longitudinal axis. Rather, the golf clubs along with sections 31 will move within the golf bag 10 based on a length of the strap 41 (see Figure 2).

Amended Claim 1 recites a golf bag carrier that comprises “a body comprising a longitudinal axis and defining a cavity adapted to contain a golf bag with a set of golf clubs therein” and “an adjustable and flexible helmet attached to said body within said cavity, said helmet configured to extend over and engage the top of the heads of said golf clubs, in an orientation substantially perpendicular to shafts of said golf clubs, and adapted to constrain said golf clubs from moving in a direction along said longitudinal axis.”

For a proper Section 102 rejection, the cited art must teach every limitation of the pending claim. With respect to Claim 1 and Salberg et al., Salberg et al. do not describe or suggest a golf bag carrier that defines a cavity for containing a golf club bag having clubs therein. Rather, and as mentioned above, Salberg et al. describe the golf bag itself. As there is no golf bag carrier cavity, Salberg et al. cannot describe a helmet attached internally to a golf bag carrier. Additionally, while the straps 54 and 56 touch the upper sections 31 of the golf stick pockets, there is no description within the Salberg et al. patent that indicates the straps prevent longitudinal movement of the golf clubs (sticks). Finally, and using the interpretation of the Examiner, that the golf bag of Salberg et al. is equivalent to the claimed golf bag carrier, than the pockets 29/31 and strap 41 do not provide the structure defined by Claim 1, that is, an ability to constrain longitudinal movement by the golf clubs.

For the reasons set forth above, Claim 1 is submitted to be patentable over Salberg et al.

Claims 2 and 3 depend, directly or indirectly, from independent Claim 1. When the recitations of Claims 2 and 3 are considered in combination with the recitations of Claim 1, Applicants submit that dependent Claims 2 and 3 likewise are patentable over Salberg et al.

For the reasons set forth above, Applicants respectfully request that the Section 102 rejection of Claims 1-3 be withdrawn.

E. The 102 Rejection over Lickton

The rejection of Claims 1-20 under 35 U.S.C. § 102(b) as being anticipated by Lickton (U.S. Patent No. 6,039,243) is respectfully traversed.

Lickton describes a container 10 that may be used to hold a golf club bag and golf clubs. The container 10 includes a lid 12, a base 14, and a dolly 16. In Figure 2, a sack 38 is illustrated as holding a golf club bag and clubs. Sack 38 is closed using a drawstring. Elsewhere in the application Lickton describes storing the container 10 within sack 38. Therefore the size of sack 38 is dependent upon the size of container 10. Lickton further describes a strap 42 used to secure the dolly 16 to the lid 12 or to the base 14.

Claim 1 recites a golf bag carrier that comprises “a body comprising a longitudinal axis and defining a cavity adapted to contain a golf bag with a set of golf clubs therein” and “an adjustable and flexible helmet attached to said body within said cavity, said helmet configured to extend over and engage the top of the heads of said golf clubs, in an orientation substantially perpendicular to shafts of said golf clubs, and adapted to constrain said golf clubs from moving in a direction along said longitudinal axis.”

Lickton does not describe or suggest an adjustable and flexible helmet configured to extend over the top of the heads of golf clubs, in an orientation substantially perpendicular to shafts of said golf clubs, and adapted to constrain golf clubs from moving in a direction along a longitudinal axis as recited in amended Claim 1. While insertion of the golf bag into the sack 38 may provide some protection for the golf bag and any clubs therein, and the sack may extend over the top of the golf club heads when the drawstring is tightened, the sack is not adapted to constrain the golf clubs from moving in a direction along a longitudinal axis, and does not meet the recitations included in Claim 1. Since the sack 38 is configured to hold the container 10 when it is in collapsed form, it likely is not properly sized for constraining longitudinal movement of the golf clubs when the sack contains the golf bag. As such neither the sack 38 nor the lid 12 meet the recitations of Claim 1 relating to the adjustable and flexible helmet.

For the reasons set forth above, Claim 1 is submitted to be patentable over Lickton.

Claims 2-8 depend, directly or indirectly, from independent Claim 1. When the recitations of Claims 2-8 are considered in combination with the recitations of Claim 1, Applicants submit that dependent Claims 2-8 likewise are patentable over Lickton.

At page 5 of the final Office Action, the Examiner states that the “term “sleeve” does not impart any structure over portion 42 in Lickton at all. However, as stated numerous times herein, for a proper Section 102 rejection, the cited art must teach every limitation of the pending claim. In the case of Claim 9, the sleeve does impart structure and cannot be simply be ignored by the Examiner. A reference that properly anticipates Claim 9 would have to include a sleeve, within the claimed cavity of the claimed body and a protective member received in the sleeve.

Claim 9 recites a golf bag carrier comprising “a body comprising a longitudinal axis and defining a cavity adapted to contain a golf bag with a set of golf clubs therein, said body comprising at least one sleeve within said cavity” and “a protective member received in said sleeve, the protective member having a first free end and a second free end, said first free end configured to extend circumferentially around the golf bag and said second free end configured to extend circumferentially around the golf bag”.

Lickton does not describe or suggest a protective member received in a sleeve where the protective member has free ends that extend circumferentially around the golf bag. Rather, Lickton at best describes that a user may utilize a sack 38, that is configured to hold the container 10 when it is in collapsed form, as a protection device when utilizing the container to hold a golf bag and golf clubs. The sleeve and protective member recited in currently pending Claim 9 is not found in the disclosure of Lickton.

For the reasons set forth above, Claim 9 is submitted to be patentable over Lickton.

Claims 10-15 depend, directly or indirectly, from independent Claim 9. When the recitations of Claims 10-15 are considered in combination with the recitations of Claim 9, Applicants submit that dependent Claims 10-15 likewise are patentable over Lickton.

Independent Claim 16 recites a golf bag carrier comprising “a body comprising a longitudinal axis and defining a cavity adapted to contain a golf bag with a set of golf clubs

therein" and "a golf club protection assembly adapted to protect the golf club shafts and the golf club heads, said protection assembly comprising an adjustable and flexible helmet configured to extend over the top of the golf club heads, in an orientation substantially perpendicular to shafts of said golf clubs, and adapted to constrain said golf clubs from moving in a direction along said longitudinal axis, and a protective member configured to extend circumferentially around the golf bag and the golf clubs".

Lickton does not describe nor suggest a golf club protection assembly including an adjustable and flexible helmet that is in an orientation substantially perpendicular to shafts of said golf clubs and adapted to constrain golf clubs from moving in a direction along said longitudinal axis. Rather, Lickton describes that a user may utilize a sack 38, that is configured to hold the container 10 when it is in collapsed form, as a protection device when utilizing the container to hold a golf bag and clubs. There is no disclosure of a protective member configured to extend circumferentially around the golf bag and the golf clubs nor anything that will constrain the golf clubs from moving in a direction along the longitudinal axis of the container 10. For these reasons, Claim 16 is submitted to be patentable over Lickton.

Claims 17-20 depend, directly or indirectly, from independent Claim 16. When the recitations of Claims 17-20 are considered in combination with the recitations of Claim 16, Applicants submit that dependent Claims 17-20 likewise are patentable over Johnson.

For the reasons set forth above, Applicants respectfully request that the Section 102 rejection of Claims 1-20 be withdrawn.

F. The 102 Rejection over Parks et al.

The rejection of Claims 1-20 under 35 U.S.C. § 102(b) as being anticipated by Parks et al. (U.S. Patent No. 6,446,851) is respectfully traversed.

Parks et al. describe a carrier 1 specifically designed to hold equipment used in the practice of paint-ball war games. In the preferred configuration, the carrier is configured as a backpack. More specifically, carrier 1 is secured to a person's back by way of a set of shoulder straps 5 and 6, chest strap (as seen in FIG. 2), and waist belt 7. (See Column 2, lines 17-20)

Now referring to an interior of container 1, an oblong pocket 14 with a cover flap 15 is shaped and dimensioned to hold a compressed gas canister 16 is included therein. Next to the pocket 14 is an arcuate wall 17 projecting orthogonally from the inner face of the central area. The recess formed by the arcuate wall 17 is dimensioned to receive either a face mask 19, goggles or similar bulky object. A bag made of netting fabric particularly convenient for housing a headband, gloves, socks, or other similar article is detachably held in the center of the recess by patches of hook-and-vane fabric fasteners 21.

In each set of flaps 9, 10, a first external one 29 forms a cover or outer wall of the carrier, a central one 37 forms a pouch 38 having a longitudinal opening 39 facing the back plate, and an inner flap 43 acts as a cover for the opening 40 of the central flap pouch to which it can be secured.

The undersigned is well aware that an intended use does not typically give rise to patentability, and the Applicant has made no such assertion. The structure of Parks does not anticipate the structure in the pending claims, notwithstanding any use of functional language. The examiner equates the waist belt 7 of Parks with the claimed helmet. The two items could hardly be more distinct, both in structure and in use. While Applicant admits the device shown in Figure 3 of Parks, if enlarged, might be capable of use as a golf bag carrier, the device disclosed by Parks simply does not include the claimed structure, which is further clarified by the functional language used in the claims.

Once again referring to MPEP 2114, even if the prior art device performs all the functions recited in the claim, the prior art cannot anticipate the claim if there is any structural difference. *In re Ruskin*, 347 F.2d 843, 146 USPQ 211 (CCPA 1965) as implicitly modified by *In re Donaldson*, 16 F.3d 1189, 29 USPQ2d 1845 (Fed. Cir. 1994).

Claim 1 recites a golf bag carrier that comprises “a body comprising a longitudinal axis and defining a cavity adapted to contain a golf bag with a set of golf clubs therein” and “an adjustable and flexible helmet attached to said body within said cavity, said helmet configured to extend over and engage the top of the heads of said golf clubs, in an orientation substantially perpendicular to shafts of said golf clubs, and adapted to constrain said golf clubs from moving in a direction along said longitudinal axis.”

Parks et al. do not describe or suggest a golf bag carrier that defines a cavity for containing a golf club bag having clubs therein. Rather, Parks et al. describe a backpack adapted to contain items related to paintball activities. Additionally, Parks et al. do not describe or suggest an adjustable and flexible helmet configured to extend over and engage the top of the heads of golf clubs. Referring to Figure 3, the arcuate wall 17 does not meet the structural limitations of the claim as it is not adjustable and flexible.

For the reasons set forth above, Claim 1 is submitted to be patentable over Parks et al.

Claims 2-8 depend, directly or indirectly, from independent Claim 1. When the recitations of Claims 2-8 are considered in combination with the recitations of Claim 1, Applicants submit that dependent Claims 2-8 likewise are patentable over Parks et al.

Claim 9 recites a golf bag carrier comprising “a body comprising a longitudinal axis and defining a cavity adapted to contain a golf bag with a set of golf clubs therein, said body comprising at least one sleeve within said cavity” and “a protective member received in said sleeve, the protective member having a first free end and a second free end, said first free end configured to extend circumferentially around the golf bag and said second free end configured to extend circumferentially around the golf bag”.

Parks et al. do not describe, nor suggest, a protective member received in a sleeve, the protective member having free ends configured to extend circumferentially around the golf bag. Additionally, the flaps described in Parks et al. are not described as having free ends that extend circumferentially around an item within the carrier. Rather, the flaps described by Parks et al. attach to one another to close the carrier.

For these reasons, Claim 9 is submitted to be patentable over Parks et al.

Claims 10-15 depend, directly or indirectly, from independent Claim 9. When the recitations of Claims 10-15 are considered in combination with the recitations of Claim 9, Applicants submit that dependent Claims 10-15 likewise are patentable over Parks et al.

Independent Claim 16 recites a golf bag carrier comprising “a body comprising a longitudinal axis and defining a cavity adapted to contain a golf bag with a set of golf clubs

therein" and "a golf club protection assembly adapted to protect the golf club shafts and the golf club heads, said protection assembly comprising an adjustable and flexible helmet configured to extend over the top of the golf club heads and adapted to constrain said golf clubs from moving in a direction along said longitudinal axis, and a protective member configured to extend circumferentially around the golf bag and the golf clubs".

Parks et al. do not describe or suggest a protection assembly comprising an adjustable and flexible helmet configured to extend over the top of the golf club heads and adapted to constrain said golf clubs from moving in a direction along said longitudinal axis, and a protective member configured to extend circumferentially around the golf bag and the golf clubs. Rather, Parks et al. infer that the arcuate wall 17 is rigid for attachment of a paintball helmet and therefore is not adjustable and flexible for constraint of the golf clubs.

For these reasons, Claim 16 is submitted to be patentable over Parks et al.

Claims 17-20 depend, directly or indirectly, from independent Claim 16. When the recitations of Claims 17-20 are considered in combination with the recitations of Claim 16, Applicants submit that dependent Claims 17-20 likewise are patentable over Parks et al.

For the reasons set forth above, Applicants respectfully request that the Section 102 rejection of Claims 1-20 be withdrawn.

#### G. The Newly Added Claims

Newly added claims 21-39 are respectfully submitted to be neither described nor suggested by the art of record. Applicants request consideration of these claims in the next communication from the Office.

#### H. Conclusion

Finally, it is respectfully submitted that none of the references mentioned above are suggestive of the invention as claimed as in combination they still do not result in the claimed structure, specifically, none of the cited references, alone or in combination, teach or suggest the claimed invention.

In view of the foregoing amendments and remarks, all the claims now active in this application are believed to be in condition for allowance. Reconsideration and favorable action is respectfully solicited.

Respectfully Submitted,



Bruce T. Atkins  
Registration No. 43,476  
ARMSTRONG TEASDALE LLP  
One Metropolitan Square, Suite 2600  
St. Louis, Missouri 63102-2740  
(314) 621-5070